

DISCUSSION OF THE AMENDMENT

Claim 1 has been amended to recite that the modification of block copolymer (I) is not a reaction of a compound containing the functional group with a polymerization initiator used to prepare the block copolymer (I).

This amendment is deemed to be at least inferentially supported in the specification by the disparate disclosures of polymer termination at page 17, lines 6-17, which describes terminating the polymerization by adding an active hydrogen compound such as an alcohol, a carboxylic acid, and water, and polymer modification at page 19, lines 9-12, which describes one method for obtaining a modified block copolymer (I). *Compare, e.g., Kennecott Corp. v. Kyocera Int'l, Inc.*, 835 F.2d 1419, 5 USPQ2d 1194 (Fed. Cir. 1987) (term “equiaxed microstructure” not literally disclosed held to be inherent property of claimed sintered ceramic body); *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) (term “not permanently fixed thereto” not literally disclosed held to be described by absence of disclosure of permanently fixed microcapsules); and *In re Voss*, 557 F.2d 812, 194 USPQ 267 (CCPA 1977) (term “crystalline content . . . at least 50% by weight” not literally disclosed held to be described by literal disclosure of “glass-ceramic material” coupled with evidence that one skilled in the art would have attributed the recited crystalline content as inherent in that material). **Copies of *Kyocera*, *Wright*, and *Voss* are enclosed.**

Claims 17-22 have been canceled.

New Claims 23-25 have been added. Claim 23 is supported in the specification at page 19, lines 9-12. Claims 24 and 25 are supported in the specification at page 12, lines 3-7.

No matter is believed to have been added by the above amendment. Claims 1-16 and 23-25 are now pending in the application. Of these claims, Claims 5-10 stand withdrawn from consideration.

REMARKS

The rejection of Claims 1-4 under 35 U.S.C. § 103(a) as unpatentable over U.S. 5,332,784 (Shiraki et al) in view of U.S. 5,700,412 (Mehra et al) and optionally U.S. 5,621,045 (Patel et al), U.S. 5,229,456 (Ilenda et al) and U.S. 5,965,627 (Allcock et al), is respectfully traversed.

In response to Applicants' argument made in the prior response that the modified block copolymer (I) of the present claims is different from the terminal modified block copolymer of Shiraki et al, the Examiner finds that the present claims do not exclude terminal modification of their block copolymer.

In reply, the above-amended claims make it clear that the modified block copolymer (I) of the present claims is not the result of a reaction with a polymerization initiator used to prepare block copolymer (I). In Shiraki et al, terminal modification is carried out by bonding a terminal-treating agent to the polymer terminal which is obtained by treating the active terminal of a block copolymer comprising conjugated dienes and vinyl aromatic hydrocarbon compounds which is obtained by use of at least one member selected from alkali metals and organoalkali metals as a polymerization initiator, wherein the terminal-treating agent is a compound containing at least one functional group selected from a Markush group thereof (column 5, line 29ff). There is no disclosure or suggestion in Shiraki et al, or in any of the other applied prior art, to in any way modify the terminal-modified block copolymer of Shiraki et al.

The above is sufficient to demonstrate patentability over the applied prior art. Thus, the applied prior art does not raise a *prima facie* case of obviousness.

Nevertheless, Applicants continue to maintain that the comparative data of record, tabulated in Tables 1 and 2 at pages 37 and 38, respectively, of the specification, and discussed in detail in the previous response, are still probative of patentability herein. While

the Examiner finds, in effect, that the results are expected, the results do not necessarily comport with the Examiner's findings. For example, the Examiner suggests that since ethylene-vinylalcohol copolymers (EVOH) are known for their gas barrier properties, it is not surprising that increasing the amount thereof increases gas barrier properties. In reply, it is noted that Example 5 has a smaller amount of EVOH copolymer compared to Examples 1, 3, and 4, yet it has better gas barrier properties than them. Nor does the data necessarily support the Examiner's finding that increasing the amount of rubber softener necessarily decreases the gas barrier properties. Compare Example 4 with Example 1, each having the same amount of EVOH copolymer. Although Example 3 has more rubber softener than Example 1, it also has superior gas barrier properties.

Applicants continue to attain that the comparative examples of the specification herein are closer to the presently-claimed invention than what the Examiner finds is the closest prior art, i.e., Example 80 of Shiraki et al.

For all the above reasons, it is respectfully requested that the rejection be withdrawn.

The rejection of Claims 17-22 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Indeed, the rejection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that this rejection be withdrawn.

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

Customer Number

22850

Tel: (703) 413-3000

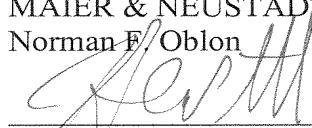
Fax: (703) 413 -2220

(OSMMN 06/04)

NFO:HAP\

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon



Harris A. Pitlick

Registration No. 38,779